

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-17 are pending in the application, Claims 1-6 and 11-17 being withdrawn. Claims 7, 8 and 10 are amended, and Claims 18-20 are canceled by the present amendment. Support for the amended claims can be found in the original specification, claims and the drawings.¹ Thus, no new matter is presented.

In the outstanding Official Action, Claims 18-20 were subject to restriction; Claim 10 was rejected under 35 U.S.C. § 102(b) as anticipated by Akester et al. (WO 97/37499, hereinafter "Akester"); Claim 10 was further rejected under 35 U.S.C. § 102(e) as anticipated by O'Neal (U.S. Patent No. 6,711,154, hereinafter "O'Neal"); and Claims 7-9 were rejected under 35 U.S.C. § 103(a) as unpatentable over O'Neal in view of Mayer (U.S. Patent No. 5,744,534).

In response to the restriction requirement set forth regarding Claims 18-20, these claims are canceled without prejudice or disclaimer.

The Official Action has rejected Claims 7-9 under 35 U.S.C. § 103 as unpatentable over O'Neal in view of Mayer. The Official Action cites O'Neal as disclosing the Applicant's invention with the exception of the information-presenting apparatus configured to store commodity information corresponding to a geographic location. The Official Action cites Mayer as disclosing this claimed feature and states that it would have been obvious to one of ordinary skill in the art to combine the reference teachings to arrive at Applicants claims. Applicant respectfully traverses this rejection as neither Mayer nor O'Neal teach or suggest specific features recited in amended independent Claims 7 and 9.

¹ See e.g., specification at page 5, lines 3-6, page 19, lines 21-24, and Fig. 6.

Briefly recapitulating, amended Claim 7 relates to a method for using an interface of an information-processing apparatus to input parameters relating to a first transmission destination, a second transmission destination in a criterion for selecting either the first and second transmission destination for receiving information from an information-presenting apparatus. A non-limiting exemplary depiction of this interface is shown in Fig. 8. Using this interface, a user is able to select various transmission destinations such as, for example, mail, fax and short messages, etc., and also indicate various other criterion that facilitates for the information-presenting apparatus to determine the information that is forwarded to the user-specified destination.

The information-processing apparatus of Claim 7 also includes a transmission controller configured to control the transmission of information relating to the first and second transmission destinations and the criterion for selecting one of the first and second transmission destinations to an information-presenting apparatus. The information-presenting apparatus then uses this information to control what information and to where the information is transmitted.

Independent Claims 7, 9 and 10 are further amended to specify that the criteria includes information corresponding to a geographic location of at least one of the first and second transmission destinations and the information-presenting apparatus stores and transmits commodity information to the transmission destinations based on a determined geographic location of the transmission destination. The claimed configuration allows a user to receive commodity information specific to a location of one of the transmission destinations, which may be, for example, their mobile phone.

Specifically, amended Claims 7, 9 and 10 are amended to clarify this feature by reciting

...wherein said criteria includes information corresponding to a geographic location of at least one of the first and second

transmission destinations and said information-presenting apparatus is configured to store and transmit commodity information corresponding to the geographic location of at least one of said first and second transmission destinations based on a determined geographic location of the at least one of said first and second transmission destinations.

The requirements for a *prima facie* case of obviousness are (1) there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference must teach or suggest all the claim limitations. It is respectfully submitted that the outstanding Official Action fails to make a *prima facie* case of obviousness, because the applied references fail to teach or suggest all the above-noted claim limitations. Further, there is no motivation to combine the O'Neal and Mayer references.

As admitted in the outstanding Official Action, O'Neal fails to teach or suggest that the information-presenting apparatus is configured to store commodity information corresponding to a geographic location.²

O'Neal, as cited in the outstanding Official Action, describes an apparatus method for device independent messaging notification. Specifically, O'Neal describes that received messages are converted into a format compatible with a data network and are delivered to a central web server.³ A user is then capable to designate, by way of user-specific criteria, which user devices receive the message alerts from the web server. At col. 10, line 64- col. 11, line 13 O'Neal describes how a user may configure his/her settings so that alerts are only generated for messages of a predetermined format (voice, fax, e-mail, etc.), and the user can also select the format of the message alert.

² The outstanding Official Action at page 6, item 13.

³ O'Neal at abstract.

However, O'Neal fails to teach or suggest that the user-selected criteria includes information corresponding to a geographic location of at least one of said first and second transmission destinations, as recited in amended Claims 7, 9 and 10. Instead O'Neal describes only that the criterion is a static rule indicating that all calls received in a specific format are directly forwarded to a specific user defined destination. At no point does O'Neal teach or suggest that geographic location is a criterion used to determine which information is transmitted and where the information is transmitted.

Therefore, O'Neal fails to teach or suggest a criterion including information corresponding to a geographic location of at least one of the first and second transmission destinations in the information-presenting apparatus configured to store and transmit commodity information corresponding to the geographic location to one of the first and second transmission destination based on a determined geographic location of at least one of first and second transmission destination, as recited in amended Claim 7.

Further, as stated above, O'Neal's system also is not capable of storing commodity information whatsoever, and therefore can not possibly transmit commodity information to one of the first and second transmission destinations based on a determined geographic location, as recited in amended Claims 7, 9 and 10.

Mayer relates to a broadcast network by which a generic telephone number is able to be associated with a predefined period of time in which an advertisement is displayed over the broadcast network.⁴ This generic telephone number can then be routed to a destination corresponding to the merchant identified in a displayed commercial advertisement.

The outstanding Official Action relies on col. 17, lines 6-9 of Mayer as describing that commodity information is stored which corresponds to a geographic location. However, this portion of Mayer describes that advertisements are broadcast to recipients located in a

⁴ Mayer at abstract.

plurality of different geographic areas at particular times. Thus, Mayer does not describe the storage of commodity information corresponding to a geographic location, but describes only that advertisements, having the same content, may be broadcast to a plurality of different geographic areas.

Amended Claims 7, 9 and 10 further recite that a stored criterion corresponds to a geographic location of at least one of the first and second transmission destinations and the information-presenting apparatus is configured to store and transmit to the one of the first transmission destinations based on a determined geographic location of the at least one of said first and second transmission destinations. As Mayer's system is a broadcast television system, it is not capable of determining a location of one of the first and second transmission destinations (televisions) so that geographically relevant commodity information can be transmitted thereto. Therefore, Mayer's system could not possibly transmit geographically relevant commodity information to a transmission destination based on geographic location, because Mayer's system includes no means by which to determine the geographic locations of the transmission destinations.

Accordingly, Applicant respectfully requests that the rejection of Claim 7 under 35 U.S.C. § 103 be withdrawn. For substantially the same reasons as given with respect to amended Claim 7 Applicants respectfully submit that amended Claims 9 and 10 also patentably define over Mayer and/or O'Neal.

Further, Applicant respectfully traverses the obviousness rejection based on Mayer as there is insufficient evidence of motivation to modify O'Neal's method for device independent messaging notification by incorporating Mayer's broadcast advertising technique, for the following reasons.

The outstanding Official Action states that the proposed modifications would have been obvious "because Mayer's teaching of storing commodity information enables O'Neal's

information-presenting apparatus to present information such as sales advertisements to the transmission destinations.”⁵ The record, however fails to provide the required evidence of motivation for a person of ordinary skill in the art to perform such a modification. While Mayer provides a reason for distributing advertisement information to transmission destinations over a broadcast television system, Mayer fails to teach or suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature in a message forwarding system such as that disclosed by O’Neal. In particular, Mayer describes transmitting television commercial information over a broadcast system to a plurality of broadcast recipients. Mayer, however, does not suggest that storing and transmitting television commercials would be an operable message forwarding or notification system, much less “enable” O’Neal’s system to present such advertisements to transmission destinations.

In fact, it is unclear from the record how O’Neal’s system or any components thereof may be operable should they be implemented in a system or apparatus such as that described by Mayer. O’Neal describes that its structure already achieves the goal of message forwarding and message notification based on received fax, e-mails and voicemail messages, but fails to suggest, in any way, that further improvement is desired, nor that another feature should be added to forward television broadcast signals to. In particular, O’Neal does not suggest or provide motivation to transmit television commercial information to users’ terminals, whatsoever.

Neither Mayer nor O’Neal, therefore provide the motivation to perform the proposed modification of O’Neal’s device. In other words, an attempt to bring the isolated teachings of Mayer’s system into O’Neal’s system would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a

⁵ The outstanding Official Action at page 6, item 13.

whole. While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from somewhere within the record. In this case, the record fails to suppose the proposed modification of O'Neal's system. See In re Bergel, 130 USPQ 206, 208 (CCPA 1961)("The mere fact that it is possible to find two isolated disclosures that might be combined in such a way to produce the [invention] does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination.")

Furthermore, it is not clear from the record how Mayer's commercial distribution broadcast system could be incorporated into O'Neal's system. Under such a modification, the infrastructure of O'Neal, which is web based, and includes converting messages into formats which can be transmitted via e-mails and portable mobile devices would have to be capable of transmitting television commercial information. Such modification would require a substantial reconstruction or redesign of the elements of O'Neal's device, and/or would change the basic principle of operation of O'Neal's device. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.

Moreover, the rejection is clearly misplaced because the proposed combination would require an extensive modification to O'Neal that, if performed, would change the desired operating principal of O'Neal as to case the terminals in his device to receive television commercials transmitted over the television broadcast system. Any proposed modification that would change the basic operating principle of a reference is not an obvious one. See In re Ratti, 123 USPQ 349, 352 (CCPA 1959).

In rejection a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record, and by "clear and particular" evidence of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the

record of motivation for modifying O'Neal's system by incorporating Mayer's commercial broadcast system. Without such motivation and absent improper hindsight reconstruction, a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 7-10 are believed to be non-obvious and patentably over the applied references.

Claim 10 was rejected under 35 U.S.C. § 102(e) as anticipated by O'Neal. Applicants respectfully request that the rejection of Claim 10 under 35 U.S.C. § 102 be withdrawn, for at least the reasons discussed above as Claim 10 is amended to recite substantially similar features to those recited in amended Claim 7.

Claim 10 was also rejected under 35 U.S.C. § 102(e) as anticipated by Akester. Applicants respectfully submit that amended Claim 10 recites features which patentably distinguish over Akester.

As discussed in the previous response, Akester describes a call routing method in which a personal number user has an associated profile and by filling out a questionnaire of the user can predetermined a number of periods in the day and the respective destination terminal numbers to which a user's incoming calls can be diverted.⁶ However, Akester simply diverts and routes calls to different user terminals on the network at different times of the day as specified by the user. At no point does Akester teach or suggest that any information is stored in an information-presenting apparatus which relates to commodity information corresponding to a specified geographic location, as recited in amended Claim 10.

Accordingly, Applicant respectfully requests the rejection of Claim 10 under 35 U.S.C. § 102 as anticipated by Akester be withdrawn.

⁶ Akester at page 1, lines 21-24.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 7-10 is not distinct and is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.


Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)



Bradley D. Lytle
Attorney of Record
Registration No. 40,073